Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TADD H. HOGG, BJORN R. CARLSON, VINEET GUPTA and ANDREW A. BERLIN

Appeal No. 2003-1580
Application No. 09/033,222

ON BRIEF

Before FLEMING, GROSS, and BARRY, ***Administrative Patent Judges.***

FLEMING, ***Administrative Patent Judge.***

REMAND TO THE EXAMINER

We remand this application to the Examiner for consideration of the following matters. The Examiner mailed a final rejection of claims 1-20 on May 17, 2002. In the final rejection, claims 1-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Fujita in view of Harada. We note that Appellants' claim 1 recites "a global controller, coupled to said computational agents, for receiving aggregate operating characteristics from, and delivering global constraints to, said computational agents." We further note that the final rejection is silent as to how the

references read on this limitation. In the brief, Appellants argue that the combination of Fujita and Harada does not teach or suggest this limitation. See pages 6-8 of the appeal brief. In the answer, the Examiner relies on Carlson for the first time for teaching a global controller. See the Examiner's answer, pages 4 and 7. In the reply brief, Appellants argue that the Examiner has made a new ground of rejection. See page 2 of the reply brief.

In the final rejection, the Examiner also rejected claims 1-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent Nos. 6,119,052, 6,039,316 and 6,027,112. The Examiner further rejected claims 1-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,634,636 in view of Fujita. In the brief, Appellants do not traverse the rejection of claims 1-20 over claims 1-20 of U.S. Patent Nos. 6,119,052, 6,039,316 and 6,027,112. Appellants state that they will submit a terminal disclaimer to overcome the rejection. However, Appellants argue that their claimed invention recited in claim 1 is non-obvious over claims 1-6 of U.S. Patent No. 5,634,636. See pages 12 and 13 of the brief. In the answer, the

Examiner states "regarding the obvious double patenting rejection in view of the '636 patent, it appears that this still applies for the same reasons as described above, if not in view of the '636 patent by itself, then in combination with Harada." See page 7 of the Examiner's answer.

As set forth in 37 CFR § 1.193(2), an Examiner's answer should not include a new ground of rejection unless a proposed amendment under § 1.116 is entered by the Examiner. We note that Appellants' proposed amendment under § 1.116 was not entered by the Examiner as set forth in the advisory action mailed July 9, 2002. However, the Examiner's reliance on the Carlson article for the rejection of claims 1-20 under 35 U.S.C. § 103 is a new ground of rejection and it is now a rejection based upon the combination of Fujita in view of Carlson and Harada.

Furthermore, the record is not clear as to whether the Examiner is maintaining the obviousness-type double patenting rejection based upon Patent Nos. 6,119,052, 6,039,316 and 6,027,112. Furthermore, it is not clear how all the limitations of claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-6 of U.S. Patent No. 5,634,636 by itself or in combination of Harada.

We request that the Examiner remove from the record the new ground of rejection of claims 1-20 under 35 U.S.C. § 103 as being unpatentable over Fujita, Carlson and Harada. If the Examiner wishes to maintain this rejection, the Examiner should re-open prosecution and then properly set forth the rejection.

We also request that the Examiner make clear the status of the obviousness-type double patenting rejections. We counsel the Examiner to maintain the rejections of claims 1-20 under the obviousness-type double patenting over claims 1-20 of Patent Nos. 6,119,052, 6,039,316 and 6,027,112. The rejection should be maintained until a terminal disclaimer has been submitted. For the obviousness-type double patenting rejection of claims 1-20 over claims 1-6 of U.S. Patent No. 5,634,636, we request the Examiner make clear exactly how the limitations set forth in Appellants' claims 1-20 are met by claims 1-6 of U.S. Patent No. 5,634,636 or by the combination of claims 1-6 of U.S. Patent No. 5,634,636 and Harada.

This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01 (Eighth Edition, Aug. 2001), item (D). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMAND TO THE EXAMINER

MICHAEL R. FLEMING
Administrative Patent Judge)
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ANITA PELLMAN GROSS) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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